



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,298	08/26/2003	Ryoji Watanabe	116869	2577
25944	7590	01/24/2008		
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			EXAMINER POPOVICI, DOV	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 01/24/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/647,298

Applicant(s)

WATANABE ET AL.

Examiner

Dov Popovici

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

*Dov Popovici*  
DOV POPOVICI  
PRIMARY EXAMINER  
ART UNIT 2625

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/26/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 11-12 are claiming a program per se. Claims 11-12 are directed to non-statutory functional descriptive material. "Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. " " Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as

nonstatutory functional descriptive material” (see Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, lines 3-5, the claimed recitation of “the data input/output unit performs the at least one with respect to the plurality of image display members” is unclear, vague and indefinite in the context of the claim. It is unclear as to what is “the data input/output unit performs the at least one with respect”? “one” what? Based on claims 1-2 and 4, it appears that applicant is trying to claim one of reading data and writing data? Clarification is required.

In claim 7, lines 6-7, the claimed recitation of “the data input/output unit performs the at least one with respect to the image display member being transported” is unclear, vague and indefinite in the context of the claim. It is unclear as to what is “the data input/output unit performs the at least one with respect”? “one” what? Based on claims

1-2 and 4, it appears that applicant is trying to claim one of reading data and writing data? Clarification is required.

In claim 8, lines 5-6, the claimed recitation of "the data input/output unit performs the at least one with respect to the fixed image display member" is unclear, vague and indefinite in the context of the claim. It is unclear as to what is "the data input/output unit performs the at least one with respect"? "one" what? Based on claims 1-2 and 4, it appears that applicant is trying to claim one of reading data and writing data? Clarification is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka Akira et al. (JP 2000285203).

As to claim 1, Tanaka Akira et al. discloses an image process system comprising: an image display member (paper incorporating an IC chip; see abstract) on which an image is displayed; and an image process apparatus, wherein: the image display member includes a data storage unit (IC chip see abstract) for storing data; and the data process apparatus includes: a image read unit (IC reader/writer 50) for reading

the displayed image; and a data input/output unit (IC reader/writer 50) for performing at least one of reading the stored data and writing another data into the data storage unit (see abstract).

As to claim 2, Tanaka Akira et al. discloses an image process apparatus comprising: a image read unit (IC reader/writer 50) for reading an image displayed on an image display member (paper incorporating an IC chip; see abstract); and a data input/output unit (IC reader/writer 50) for performing at least one of reading data stored in the image display member and writing another data into the image display member (see abstract).

As to claim 3, Tanaka Akira et al. discloses an image process unit (CPU; see abstract) for processing the read image on the basis of the read data.

As to claim 9, Tanaka Akira et al. discloses an image process method comprising: reading data (see abstract; IC reader/writer 50 reads out electronic data from the IC part) stored in an image display member (image display member reads on: the paper incorporating an IC chip; see abstract); and reading image displayed on the image display member (see abstract).

As to claim 10, Tanaka Akira et al. discloses writing another data into the image display member (see abstract, IC reader/writer 50 records converted electronic data in an IC part 3 of paper incorporating the IC chip).

As to claim 11, Tanaka Akira et al. discloses a program making a computer perform a process comprising: reading data (see abstract; IC reader/writer 50 reads out electronic data from the IC part) stored in an image display member (image display

member reads on: the paper incorporating an IC chip; see abstract); and reading image displayed on the image display member (see abstract).

As to claim 12, Tanaka Akira et al. discloses wherein the process further includes: writing another data into the image display member (see abstract, IC reader/writer 50 records converted electronic data in an IC part 3 of paper incorporating the IC chip).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka Akira et al. (JP 2000285203).

As to claim 4, Tanaka Akira et al. discloses wherein: the data input/output unit (IC reader/writer 50) performs the at least one of reading the data stored in the accumulated image display member and writing another data into the accumulated image display member.

Tanaka Akira et al. does not teach an original accumulation unit for accumulating the image display member; and a transport unit for transporting the accumulated image display member to a position where the displayed image is read.

The examiner is taking official notice that a copier and/or a copy machine which includes an original accumulation unit for accumulating the image display member or original paper; and a transport unit for transporting the accumulated image display member or original paper to a position where the displayed image is read are well known in the photo copying and/or copier art and technology.

Therefore, it would have been obvious to one person having ordinary skill in the art at the time the invention was made to have modified Tanaka Akira et al. apparatus to include: an original accumulation unit for accumulating the image display member or original paper; and a transport unit for transporting the accumulated image display member or original paper to a position where the displayed image is read.

It would have been obvious to one person having ordinary skill in the art at the time the invention was made to have modified Tanaka Akira et al. apparatus to include an original accumulation unit for accumulating the image display member or original paper; and a transport unit for transporting the accumulated image display member or original paper to a position where the displayed image is read so that multiple original papers can be accumulated and transport to the scan area to be read automatically, therefore, relieve the user(s) or operator(s) from having to singularly feed the original paper to the apparatus to be read and/or scanned, whereby, in a large job having a large number of original papers to be read and/or scanned, the accumulation unit and the transport unit can accumulate, transport, deliver and handle the multiple original papers, without user(s) intervention.



As to claim 5, Tanaka Akira et al. as modified discloses wherein when the accumulated image display member is a plurality of image display members, the data input/output unit (IC reader/writer 50) performs the at least one with respect to the plurality of image display members.

As to claim 6, Tanaka Akira et al. as modified discloses further comprising: a display unit (printer or output unit 40 see page 3 of 23 paragraphs 0021 and 0022) for displaying the read data, wherein: when the image display member is accumulated at the original accumulation unit, the data input/output unit performs reading the stored data.

As to claims 7-8, Tanaka Akira et al. discloses wherein: the data input/output unit (IC reader/writer 50) performs the at least one with respect to the image display member.

Tanaka Akira et al. does not teach a transport unit for transporting the accumulated image display member to a position where the displayed image is read, wherein: the data input/output unit performs the at least one with respect to the image display member being transported, and a fix unit for fixing the image display member at a position where the displayed image is read, wherein: the data input/output unit performs the at least one with respect to the fixed image display member.

The examiner is taking official notice that a copier and/or a copy machine which includes a transport unit for transporting the accumulated image display member or the original paper to a position where the displayed image is read, and a fix unit for fixing

the image display member or the original paper at a position where the displayed image is read are well known in the photo copying and/or copier art and technology.

Therefore, it would have been obvious to one person having ordinary skill in the art at the time the invention was made to have modified Tanaka Akira et al. apparatus to include: a transport unit for transporting the accumulated image display member to a position where the displayed image is read, wherein: the data input/output unit performs the at least one with respect to the image display member being transported, and a fix unit for fixing the image display member at a position where the displayed image is read, wherein: the data input/output unit performs the at least one with respect to the fixed image display member.

It would have been obvious to one person having ordinary skill in the art at the time the invention was made to have modified Tanaka Akira et al. apparatus to include a transport unit for transporting the accumulated image display member to a position where the displayed image is read, wherein: the data input/output unit performs the at least one with respect to the image display member being transported, and a fix unit for fixing the image display member at a position where the displayed image is read, wherein: the data input/output unit performs the at least one with respect to the fixed image display member, so that multiple original papers or image display members can be transported and hold or fixed at the scanning position area to be read automatically, therefore, relieving the user and/or operator from having to feed or singularly feed the original paper or the image display member to the apparatus to be read or scanned,

whereby, in a large job having a large number of original papers to be read or scanned, the transport unit and the fix unit can accumulate, transport, deliver and handle the multiple original papers or image display members to the position where data can be read or written into the IC chip, without any user intervention, and automatically.

### ***Conclusion***

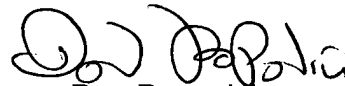
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dov Popovici whose telephone number is 571-272-4083. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:  
10/647,298  
Art Unit: 2625

Page 11

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dov Popovici  
Primary Examiner  
Art Unit 2625